

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-26 are currently pending and stand rejected. Applicant has amended claims 1, 3-4, 7, 9-10, 12, 14-18, and 21-23. No new matter has been added.

Applicant has amended the claims for clarification purposes only without changing the scope of the claims. The amended claims therefore do not raise any new grounds of rejection. Entry of the amendment is respectfully requested.

Formal issues

The Office Action objected to the drawings under 37 CFR § 1.83(a) because they do not show the motor recited in claims 1 and 14. Applicant has amended the claims to eliminate explicit recitation of the motor. Applicants note, however, that the claims do recite the relationship between portions of the actuator and a motor. The motor itself provides context for the inventive actuator and is not an explicitly claimed element. One of ordinary skill in the art would understand how the inventive actuator cooperates with a motor in the claimed manner. The drawings therefore conform to 37 CFR § 1.83(a). Withdrawal of the objection is therefore respectfully requested.

§ 112 rejection

Claim 12 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant has corrected the antecedent basis problem helpfully noted by the Examiner. Withdrawal of the rejection is therefore respectfully requested.

§ 102 rejection

Claims 1, 2, 5-7, 9, 10 and 12-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 684 356 (EP '386). Applicant respectfully traverse this rejection.

With respect to independent claims 1 and 14, the Office Action asserted that EP '356 discloses the claimed gear wheel (i.e., reduction gear 5), output element (i.e., cam 7) and resilient transfer device (i.e., elastic member 19). Applicant respectfully disagrees.

First, the cam 7 cannot be considered the same as the claimed output element because the elastic member 19 is not operably disconnectable from the cam 7 to allow independent movement of the cam. Although the Office Action asserted that "the drive transfer device is inherently operably disconnectable from the output lever" (p. 3), Applicant respectfully notes that this is an improper inherency argument.

The Federal Circuit has clearly stated that inherency cannot be established simply by asserting that a certain thing may result from a given set of circumstances. To support an inherency argument, the disclosure offered by the Examiner must be "sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function" and that the missing claimed element is "necessarily present" in the reference such that it would be recognized by persons of ordinary skill. Finnegan Corp. v. ITC, 51 USPQ2d 1001 (Fed. Cir. 1999), quoting In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Further, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" MPEP § 2112. To rely upon an inherency theory, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" MPEP § 2112.

The Office Action has failed to meet this burden. More particularly, the Office Action failed to explain how disconnection of the elastic member from the cam 7 to allow the cam 7 to move independently is a natural result of the teachings in EP '356. EP '356 assumes that the elastic member 19 is always fitted to the cam 7 (col. 11, line 52 to col. 3, line 12; col. 3, lines 37-45; col. 13, lines 34-48). In fact, as can be seen in Figures 16 and 17, there is no way for the elastic member 19 to disengage from the cam 7, let alone allow the cam 7 to move independently. Thus, contrary to the Office Action's assertion, EP '356 does not teach a drive transfer device that is operably disconnectable from the output element as recited in independent claims 1 and 14.

With respect to independent claim 21, nothing in EP '396 inherently shows stops that are movable relative to one another. Although the Office Action asserted that "the stop member is inherently resiliently movable by changing of an angle between the forward stop arm and the

reverse stop arm" on the stop member (which the Office Action assumed to be actuating lever 8), Applicant respectfully disagrees.

The actuating lever 8 is clearly not a resilient member because it is designed to move a door lock unit DL to lock and unlock the door when it receives torque (see, e.g., col. 8, lines 16-38). Actuating levers in door latch assemblies are known in the art to be rigid; thus, any interpretation to the contrary must be explicitly taught. Applicant reiterates the inherency arguments above and notes that nothing in EP '356 indicates that movable stop arms are a natural result flowing from its teachings. As clearly shown in Figure 14, for example, the actuating lever 8 is a unitary piece that does not have any portion that is movable relative to another portion. Further, nothing in EP '396 indicates that the stopper walls 8d and 8e are resiliently movable relative to each other. Thus, EP '396 fails to disclose a forward stop device resiliently movable relative to a reverse stop device as recited in claim 21.

Because EP '396 fails to disclose every claimed element, EP' 396 does not anticipate claims 1, 2, 5-7, 9, 10 and 12-26. Withdrawal of the rejection is therefore respectfully requested.

Applicant thanks the Examiner for indicating that claims 3, 4, 8 and 11 would be allowable if rewritten in independent form. As explained above, however, EP '396 fails to anticipate any of the pending claims. Thus, claims 3, 4, 8 and 11 are allowable without any amendment.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited. Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anna M. Shih', written over a horizontal line.

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CERTIFICATE OF MAIL

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of August, 2003.


Beth A. Beard